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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,337	12/15/2003	David L. Polston	P-109301.2 (UTI)	3734

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EXAMINER	
BRUNSMAN, DAVID M	
ART UNIT	**PAPER NUMBER**
1755	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/736,337	POLSTON, DAVID L.	
	Examiner	Art Unit	
	David M. Brunsman	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,9 and 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,9,10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 March 2006 has been entered.

Applicants submission amends the independent claims to require that the quantity of aggregate and said oil and gas waste material are each stored separate and apart from each other. The Remarks filed therewith propose that this element is missing from the references relied upon.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Reference B3 as illuminated by Reference C1.

Reference citation identifiers (e.g. B3 and C1) have been added to the completed Information Disclosure Statements attached.

The instant claims are drawn to a method of preparing a composition for use as a road base wherein oil and gas waste material (described as oilfield waste at paragraph 34 of the specification) are mixed with an aggregate material and then combined with a binder to form road base. Reference B3 describes a report detailing the operations of an Osage Environmental waste treatment facility as of September 11, 1999. In this operation, oilfield (first site) waste is trucked to the facility and held on an impervious concrete pad (third

site), whereafter it is mixed with an aggregate (caliche) obtained from elsewhere (second site) about the facility.

The instant claims have been amended to include the limitation that the aggregate is stored separately and apart from the oil and gas waste at the third site. No patentable distinction can be seen between the limitation added and the oil and gas waste being held inside the facility for any length of time on the trucks that deliver it, as described in the prior art relied upon. Furthermore, no patentable distinction can be seen between limitation requiring that the aggregate be stored separately from the oil and gas waste and said aggregate being held within the heavy equipment used to move it onsite for any length of time.

Page 6 of 12 of document C1 describes the receiving ramp upon which waste is unloaded as an 8 inch thick concrete pad and describes the pad upon which treated waste is to be stored as a 4 inch thick concrete pad. While the inspection discussed in document B3 appears to "catch" the waste handler unloading and mixing the waste directly on the ground, the waste handler's attached response assures the regulatory agency the waste will be unloaded and stored on the receiving pad; at latest, conforming to isolation from the ground as of 06 February 2000.

The concrete pad is part of an area including a large impervious caliche pit surrounded by built up berms to isolate the area. The treated waste is stored pending its combination with asphalt emulsion and cement to form the desired road base material. Specific details, including the concrete berms/walls surrounding the concrete pad, of the physical layout and construction of the waste treatment facility can be more easily found in the reference C1. The report B3 details sampling and testing of the materials before the storing step and after the mixing step done for the report, as well as, the ongoing documentation and testing necessary to comply with the reporting requirements set forth

therein. See also, reference C1. The report constitutes convincing evidence that the process of the instant claims was in public use starting no later than September 11, 1999. Applicant is invited to provide any further documentation detailing the process that has been performed at this site *along with a clear explanation* of the manner in which that documentation supports or does not support a finding that the claimed invention was in use prior to the filing of the instant priority document.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the documents B3 and C1, above in view of CHEMICAL ENGINEER'S HANDBOOK.

The difference between the process disclosed in the prior art above and the instant claims is the method of transporting the oil and gas waste. The documents relied upon only describe transport by truck. Pages 7-47 and 7-48 show transportation of bulk materials may be by truck, rail or boat. It would have been obvious to one of ordinary skill in the art to ship by boat because this reference teaches they are known equivalents for transporting bulk materials.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 6 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 7, 11 and 12 of copending Application No. 10/801410. Although the conflicting claims are not identical, they are not patentably distinct from each other the instant claims would be anticipated or made obvious by the '410 claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The '410 application claims a process wherein drilling waste is transported from a first location and aggregate from a second location to be stored at a treatment (third) site. The waste and aggregate are mixed on an impervious layer, tested for leachate and physical properties and combined with a binder to produce an environmentally safe road base material. Claims 1, 2 and 6 would be anticipated. Claim 3 differs from the '410 claims in that the waste material is to be tracked and the results archived. It would have been obvious to one of ordinary skill in the art to track and archive the results of the waste material because such recordkeeping is notorious for complying with regulatory reporting requirements. Claims 7-9 differ from the '410 in specifying the nature of the impervious layer. The '410 claims require an impervious layer. It would have been obvious on its face to employ a natural layer if one was available or create a man-made one if not. There is no showing that such would be anymore than simple design choice.

Claims 4-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 7, 11, 12 of copending Application No. 10/801410. Although the conflicting claims are not identical,

they are not patentably distinct from each other. The Request for Continued Examination filed comprising a proper response to a final rejection, a timely filed terminal disclaimer or other appropriate action is again due in response to this rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 4 and 5 differ from the '410 claims in that the waste is required to be transported by truck or boat. CHEMICAL ENGINEER'S HANDBOOK teaches bulk materials may be transported by truck, rail or boat. It would have been obvious to one of ordinary skill in the art to transport the waste by truck or boat because it has been shown as a known bulk transport method.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunsman
Primary Examiner
Art Unit 1755

DMB